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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,033	02/04/2004	Jed E. Rose	014622.000001	2032

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EXAMINER

LAYNO, BENJAMIN

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/708,033

Applicant(s)

ROSE ET AL.

Examiner

Benjamin H. Layno

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>092304</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Dwyer.

The patent to Dwyer discloses playing cards divided into a first suit having 26 cards, and a second suit having 26 cards. Each card of the first suit has a legend of a letter of the alphabet “A” – “Z” and a picture. Each card of the second suit also has a legend of a letter of the alphabet “A” – “Z” and a picture, but varying in color of border design.

The playing cards also comprise “wild” cards, col. 6, lines 22-23.

In regard to claims 3-7 and 11, the only difference between the legends and pictures on the cards of the claimed invention, and the legends and pictures on Dwyer’s cards resides in the meaning and information conveyed by printed matter. Such differences are considered unpatentable, *Ex parte Breslow*, 192 USPQ 431.

Furthermore, in *Gulack*, the Court concluded that the claimed printed matter should be given patentable weight because there was a functional relationship between the printed matter and the substrate, in that the printed matter was an endless sequence of digits and the substrate was an endless band, such that the band “presented the digits as an endless sequence with no discrete beginning or end.”

Gulack, 703 F.d. at 1382, 217 USPQ2d at 402. By contrast, in the present case, there

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is no functional relationship between the substrate (Applicant's cards) and the matter in question (Applicant's legends and pictures) printed on it. The Applicant's cards merely serves the same purpose as the Dwyer's cards, namely, both the Applicant's cards and Dwyer's cards provide a substrate or support for the legends and pictures such that the legends and pictures can be displayed for the convenience of the players. Therefore, the Applicant's legends and pictures recited in claims 3-7 and 11 do not patentably distinguish from Dwyer's legends and pictures proposed by the Examiner.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 12-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calhoun in view of Bouchal 799'.

The patent to Calhoun discloses a method of playing a card game comprising providing a deck having a first suit (sentence cards) 10 and a second suit (picture cards) 14. The first suit and second suit area separated from each other. To play Calhoun's game, a player selects a sentence card from the first suit, and selects at least one picture card from the second suit, col. 5, lines 56-58. The player then must explain to the opposing players how the pictorial elements 16 on the selected picture card 14 relate to the words that make up the sentences 12 on the selected sentence card 10. A time keeper 26 is used to place a time restriction on the player's explanation. Then the

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other players judge the player's explanation by giving a score from zero points to a selected number of points, col. 7, lines 26-39, see Fig. 7. Play continues with another player until all cards have been selected.

The patent to Bouchal 799' teaches that it is known in card games for players to observe the legends and pictures on displayed cards, and use the legends and pictures to tell a story. In view of such teaching, it would have been obvious modify Calhoun's rules, wherein instead of providing an explanation of how a picture card relates to a sentence cards, the player of have told a story based on the pictures on the picture card and the sentences on the sentence card. This modification would have helped players in their storytelling skills.

In regard to claims 13, 17-20, the Applicant is referred to the *Ex parte Breslow* and *Gulack* decisions above.

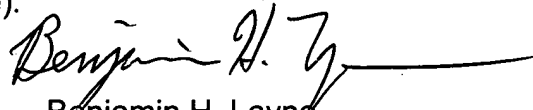
5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Fields and Salinger disclose fortune telling cards games having playing cards with legends and pictures. The patents to Loayza, Bouchal 135' and Taylor disclose story telling games.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin H. Layno whose telephone number is (703) 308-1815. The examiner can normally be reached on Monday-Friday, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Benjamin H. Layne
Primary Examiner
Art Unit 3712

bhl